

REMARKS

Claims 1-3 and 5-23 are pending in the present application. Claims 1-3, 5-15 and 19-23 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kawasaki, U.S. Patent Application Publication No. 2001/0030801, in view of Westphal, U.S. Patent No. 4,576,450, and further in view of Tandler et al., U.S. Patent No. 6,088,155. Claims 16-18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kawasaki in view of Westphal and Tandler and further view of Sato, U.S. Patent No. 5,519,531.

The claims have been amended. Reconsideration of the application is respectfully requested.

Rejections under 35 U.S.C. §102(b), 103(a)

Claims 1-3, 5-15 and 19-23 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kawasaki, U.S. Patent Application Publication No. 2001/0030801, in view of Westphal, U.S. Patent No. 4,576,450, and further in view of Tandler et al., U.S. Patent No. 6,088,155. Claims 16-18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kawasaki in view of Westphal and Tandler and further view of Sato, U.S. Patent No. 5,519,531.

Independent claim 1 of the present application has now been amended so as to recite

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the beam splitting device including a Bauernfeind prism, the Bauernfeind prism being configured to reflect therein at least a portion of the light beam twice so as to deflect the at least a portion of the light beam to the beam deflecting unit, the Bauernfeind prism being disposed at a first distance perpendicular from an extension of the optical axis;

...  
wherein an axis of rotation of the beam deflecting unit is disposed at a second distance perpendicular from the extension of the optical axis, the second distance being greater than the first distance

Support for the amendment to claim 1 may be found, for example, at paragraphs [0011] and [0012]

of the specification and in Fig. 1. It is respectfully submitted that none of Kawasaki, Westphal or Tandler, nor a combination thereof, teach or suggest a Bauernfeind prism configured to reflect therein at least a portion of the light beam twice so as to deflect the at least a portion of the light beam to the beam deflecting unit, where the Bauernfeind prism is disposed at a first distance perpendicular from an extension of the optical axis, and an axis of rotation of the beam deflecting unit disposed at a second distance perpendicular from the extension of the optical axis, where the second distance is greater than the first distance, as now recited in amended claim 1. In contrast, in the lens barrel of Kawasaki the distance between the optical axis (not numbered) and the mirror M1 is greater than the distance between the optical axis and the point P. Nor is there any Bauernfeind prism disclosed in Kawasaki at all, much less a Bauernfeind prism having the features now recited in claim 1. See Kawasaki Fig. 1. In Westphal, there is also no Bauernfeind prism. Westphal merely describes a microscope tube having a trapezoidal prism 7 that reflects light, via a beam-splitting cube 8, to a hinged mirror 16. The beam-splitting cube reflects part of the light to bayonet mount openings 6. See column 3, line 67, to column 4, line 8, and Fig. 2. Regarding Tandler, that reference merely shows a Bauernfeind prism 4 that divides a beam S coming from an objective 1, but neither teaches nor suggests the other features recited in claim 1. See Tandler Fig. 1a.

Nor would it have been obvious to somehow combine the trapezoidal prism of Westphal and the Bauernfeind prism of Tandler with the lens barrel of Kawasaki to provide the invention now recited in claim 1. First, providing a Bauernfeind prism at the location along the beam path between P1 and M1, as proposed by the Office Action (see drawing on page 5 of the Office Action), would not meet at least the limitation that the Bauernfeind prism is configured to reflect therein at least a portion of the light beam twice so as to deflect the at least a portion of the light beam to the beam deflecting unit, as now recited in claim 1. Second, replacing the mirror M1 of Kawasaki with the Bauernfeind prism of Tandler would not meet the limitation that the second distance is greater than the first distance, as recited in claim 1. Nor would a person of ordinary skill in the art have attempted to replace the mirror M1 of Kawasaki with the Bauernfeind prism of Tandler but in a different position along the beam path that would somehow meet the limitations now recited in

claim 1. It is not apparent that there is any position of such Bauernfeind prism that would meet the limitations that the Bauernfeind prism is configured to reflect therein at least a portion of the light beam twice so as to deflect the at least a portion of the light beam to the beam deflecting unit, where the Bauernfeind prism is disposed at a first distance perpendicular from an extension of the optical axis, and an axis of rotation of the beam deflecting unit disposed at a second distance perpendicular from the extension of the optical axis, where the second distance is greater than the first distance, as now recited in claim 1, while still providing a functioning lens barrel in Kawasaki. It is not apparent that such a construction would provide a functioning device, and in any event would have required such a substantial reconfiguration of the Kawasaki lens barrel, that a person of ordinary skill in the art would have had no reason to attempt it. Thus, such a modification would not have yielded predictable results or otherwise have been obvious to a person of ordinary skill in the art.

For all of the above reasons, it is respectfully submitted that a combination of Kawasaki, Westphal and Tandler, to the extent proper, could not have rendered independent claim 1 or any of its dependent claims obvious.

Withdrawal of the rejection of claims 1-3, 5-15 and 19-23 under 35 U.S.C. §103(a) based on Kawasaki in view of Westphal and further in view of Tandler, and of claims 16-18 under 35 U.S.C. §103(a) based on Kawasaki in view of Westphal and Tandler and further in view of Sato, is respectfully requested.

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Docket No.: 20793/0204560-US0

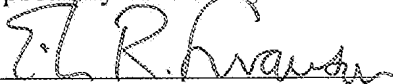
### CONCLUSION

In view of the above amendment, applicants believe the pending application is in condition for allowance.

The Commissioner is hereby authorized to charge any unpaid fees deemed required in connection with this submission, including any additional filing or application processing fees required under 37 C.F.R. §1.16 or 1.17, or to credit any overpayment, to Deposit Account No. 04-0100.

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Respectfully submitted,

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